

## REMARKS

By this amendment claim 1 is amended to simplify the claimed molecule by reciting B<sub>n</sub> as a chemical bond and to remove possible intervening proteins between protein(Y) and T. In essence, n and m are limited to a value of zero. Claims 27-29 are added to explicitly recite the hand of man. Claims 1, 6-12 and 27-29 are pending. No issue of new matter arises.

### **Rejections under 35 U.S.C. §112, first paragraph**

Rejection of claims 1-3 and 6-12 was maintained under 35 U.S.C. §112, first paragraph as allegedly failing to meet written description and enablement requirements. Applicant respectfully traverses these rejections.

#### ***Written Description***

Claim 1 is amended to simplify the molecule and exclude non-specific codons of B<sub>n</sub> and generic or unspecified proteins previously recited as protein(Y<sub>m</sub>). Applicant respectfully submits that the simplified molecule can be said to even more adequately meet the written description requirement. Claims 6-12 ultimately depend from claim 1 and thus claim inventions that further limit the invention claimed in claim 1. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#### ***Enablement***

Claim 1 is amended to simplify the molecule and exclude non-specific codons of B<sub>n</sub> and generic or unspecified proteins previously recited as protein(Y<sub>m</sub>). Applicant respectfully submits that the simplified molecule can be said to even more adequately meet the enablement requirement. See, e.g., the Office Action at page 4, where the specification is acknowledged as being enabling for described examples. Claims 6-12 ultimately depend from claim 1 and thus claim inventions that further limit the invention claimed in claim 1. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Provisional Double Patenting Rejections**

Claim 1 was provisionally rejected under a judicially created concept of double patenting. If still proper, Applicant will take appropriate action, such as an amendment or

other action in this or one of the conflicted applications if and when claims are finalized by indication of allowable claimed subject matter.

### **New Rejections and Objections**

#### ***Rejection under 35 USC §101 - Non-Statutory Subject Matter***

Claims 8, 11 and 12 were rejected as reciting non-statutory subject matter. The Examiner suggested inserting “‘isolated’ or purified” to indicate the hand of the inventor. Applicants respectfully traverse this rejection.

Applicant respectfully submits that the nucleic acid of claim 1 is a man-made molecule. Accordingly, host cells of claims 8, 11 and 12 which ultimately comprise the man-made molecule demonstrate the hand of man. Reconsideration and withdrawal of this rejection are respectfully requested.

New claims 27-29 recite “engineered host cell”. This expression is deemed to explicitly indicate the hand of man. Applicant preferred this to reciting “an isolated host cell” as such cells exist in culture and may or may not be clonal. These claims are believed allowable. The Examiner is invited to suggest alternate language if he believes the claims would be improved.

#### ***Rejection under 35 USC §102(b) -Anticipation***

Claims 1 and 6-12 were rejected as allegedly being anticipated over Dawson. Claim 1 is amended to recite to recite “protein(Y), selected from the group consisting of mini-proinsulin and proinsulin, comprises a nucleic acid sequence encoding a protein that is produced and secreted by yeast”. At least this limitation is not taught by the applied reference. Reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of all pending rejections. Applicants respectfully submit that the application is now in condition for allowance and request prompt issuance of a Notice of Allowance. Should the Examiner believe that anything further is desirable that might put the

application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

Fees

No fees are believed to be necessitated by the instant response. However, should this be in error, authorization is hereby given to charge Deposit Account no. 18-1982 for any underpayment, or to credit any overpayments.

Respectfully submitted,



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George S. Jones, Reg. No. 38,508  
Attorney for Applicant

sanofi aventis U.S. Inc.  
Patent Department  
Route #202-206 / P.O. Box 6800  
Bridgewater, NJ 08807-0800  
Telephone (908) 231-3776  
Telefax (908) 231-2626

sanofi aventis Docket No. DEAV2001/0007 US NP